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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,961	05/10/2001	Dirk M. Beyer	10013654-1	6594

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2 **Office Action Summary**

Application No.

09/853,961

Applicant(s)

BEYER ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

*Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remaining features of the claims, does not reasonably provide enablement for "said first event is a customer" (at lines 1-2 of claim 3 and at line 2 of claim 22). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. An event is an occurrence. The specification does not enable any person skilled in the pertinent arts to make a person an event. Indeed, while certain events associated with a person (e.g., their birth) can be an event, a person can never be an event.
3. This rejection can be satisfied by amending "said first event is a customer, said customer visiting a web site" to -- said first event is a customer visiting a web site --. Support for this amendment is provided by para. [0071] of the published spec. (US 20020178052A1).
4. Claims 11-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remaining features of the claims, does not reasonably provide enablement for the following in claim 11, lines 5-8 (emphasis added):

"determining which of a plurality of segments, a first segment, said customer most closely resembles, **said first segment further comprising a plurality of advertising promotions;**"

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The specification does not enable any person skilled in the pertinent arts to make a customer resemble a segment, which is to say make a customer resemble a piece of something. Furthermore, the specification does not enable any person skilled in the pertinent arts to make **said first segment comprise a plurality of advertising promotions.**

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That is, the specification does not enable any person skilled in the pertinent arts to make a segment that includes or is made up of advertising promotions. Claim 12 and spec. para. [0006] explain segments in the context of the invention.

5. This rejection can be satisfied by amending the claim language in para. 4 above to the following (emphasis is added for clarity, and is not intended to become part of the claim):

-- determining which of a plurality of segments, a first segment, said customer most closely falls within, said first segment being targeted with a plurality of advertising promotions --.

Support for this amendment is provided by para. [0006] and [0007] of the published spec.

6. Claims 5, 13 and 24 are rejected under 35 U.S.C. 112, first paragraph because of the use of the phrase "amount of times". 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The subject phrase is not idiomatic English (Merriam-Webster's Collegiate Dictionary comment on the usage of "amount [noun].) This rejection can be satisfied by amending the claim language to -- number of times -- at claim 5, line 7, claim 13 line 4 and claim 24 line 7.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "performing said first task". There is insufficient antecedent basis for this limitation in the claim. This rejection can be satisfied by amending the phrase to -- determining said first task --.

### ***Claim Objections***

9. Claims 5, 13 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. To be effective, dependent claims must add a technological or functional limitation. The subject claims limit the first distribution to being a

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"vector", which is an abstraction, and therefore not recognized as technological or functional matter under 35 USC 101. This objection can be satisfied by amending the claim language from "wherein said first distribution is a vector" (at claim 5, lines 1-2, claim 13 lines 1-2 and claim 24 lines 1-2) to (where emphasis is added for clarity, and is not intended to become part of the claim) – wherein said first distribution is accessed as a vector –. Such an amendment is supported as functional language by para. [0047] of the published specification.

### ***Specification***

10. The specification is objected to because of the use of the phrase "amount of times" on spec. p. 10, line 8 of the first full para. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The subject phrase is not idiomatic English (para. 6 above). This objection can be satisfied by amending the subject phrase to – number of times –.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannon (US006286005B1).
13. Cannon teaches (independent claims 1, 11 and 20) a method of task selection and selecting an advertising promotion, and a computer system, the method comprising the steps of a first event in a sequence of events occurs (a *viewing event*, col. 9 line 55, occurring at some arbitrary point in the future), each event in said sequence of events associated with a plurality of tasks (presenting *advertising campaigns*, col. 22 lines 15-20); determining a first distribution of said plurality of tasks (*spots A, B and C*, col. 39 lines 6-7) calculated before a

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first task is selected in association with said first event, said plurality of tasks including said first task; determining which of said plurality of tasks, said first task, when selected provides a second distribution (*spots A, B and C with spots D, E, F or G added*, col. 41 lines 54-57) of said plurality of tasks that is closest to a desired distribution (that which maximizes the score  $S_c(a)$ , para. 15 below) of said plurality of tasks; and expanding the media campaign from three to four or five spots (col. 41 lines 59-64), which reads on selecting said first task in association with said first event.

14. For claim 11, Cannon also teaches: visitors to web pages (col. 14 lines 31-34) and viewers as customers (col. 52 lines 55-56), which reads on receiving a customer at a web site; determining which of a plurality of segments (*demographic groups*) said viewer/customer most closely resembles (falls within) said first segment further comprising (being targeted with) a plurality of advertising promotions (col. 22 lines 15-20 and col. 28 lines 43-44); (maximizing the score  $S_c(a)$  (col. 38 lines 21-64 and col. 41 lines 41-59), which inherently reads on providing the least mathematical distance with respect to a desired distribution (i.e., that with maximum  $S_c(a)$ ) of said plurality of advertising promotions *D, E, F, and G* (col. 39 lines 4-15 and col. 41 lines 54-57), to achieve an objective (col. 32 lines 45-49).
15. Cannon also teaches at the citations given above claims 3, 6-9, 10, 12, 16-19, 22, 25-27, 29 and 30.
16. Cannon also teaches: claims 2, 18 and 21 (col. 3 lines 53-59 and col. 32 lines 49-51); claims 5, 13 and 24, where the formula for  $S_c(a)$  (para. 15 above) reads on a vector and with said plurality of components defining the amount (number) of times each of said plurality of tasks has been selected (col. 35 lines 8-9); claim 14 (col. 1 lines 48-51); and claim 28 (col. 31 line 44).
17. Cannon does not explicitly teach (claims 4 and 23) that said plurality of tasks/advertising promotions is offered individually to said sequence of viewers/customers. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Cannon does teach applying the invention to a web site, where it is inherent that said viewers/customers arrive in sequence, so said plurality of tasks/advertising promotions would have to be offered to said viewers/customers individually, in sequence.

***Suggestion of Allowable Subject Matter***

18. The instant rejection over Cannon (para. 12-17 above) can be overcome by amending "a desired distribution" in independent claims 1, 11 and 20 to – a specified distribution – and rearranging the wording (e.g., mention said specified distribution in a first step, not in the last step) to make it clear that said specified distribution is not merely a goal, but rather is chosen *a priori*. Support for this amendment is in the title and para. [0021]. [0042]. [0052], [0053] and [0089] of the published specification.
19. Applicant is invited to propose a specific amendment in an interview.
20. Applicant is cautioned that an allowance could not be considered until this or any other amendment was searched.

***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
22. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.<sup>1</sup> The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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<sup>1</sup> 571-272-6724 after the middle of April 2005.

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24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER



Donald L. Champagne  
Primary Examiner  
Art Unit 3622

9 March 2005